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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,451

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Elke Bleuel

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12/07/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GILLESPIE, BENJAMIN

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

12/07/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/567,451	Applicant(s) BLEUEL ET AL.	
	Examiner BENJAMIN J. GILLESPIE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 4-8 10-21 is/are rejected.
- 7) ☒ Claim(s) 3 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The current rejection is the same as previously set forth in the non-final office action mailed 6/18/2009. Therefore, it is proper to make the current action FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Obviousness Rejection I

3. **Claims 1-2, 4, 6-8, 10-12, 14-18, and 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling et al ('759) in view of Waddington et al (2003/0100699).

4. **Regarding claims 1, 10, and 15:** The rejection has been previously set forth in paragraphs 30-33 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.

5. **Regarding claims 2 and 12:** The rejection has been previously set forth in paragraph 34 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
6. **Regarding claims 4 and 6:** The rejection has been previously set forth in paragraph 36 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
7. **Regarding claim 7:** The rejection has been previously set forth in paragraph 37 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
8. **Regarding claim 8:** The rejection has been previously set forth in paragraph 38 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
9. **Regarding claims 11 and 20:** The rejection has been previously set forth in paragraph 39 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
10. **Regarding claim 14:** The rejection has been previously set forth in paragraph 40 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
11. **Regarding claims 16 and 21:** The rejection has been previously set forth in paragraph 41 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.
12. **Regarding claims 17 and 18:** The rejection has been previously set forth in paragraph 42 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.

Obviousness Rejection II

13. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling et al ('759) in view of Waddington et al (2003/0100699) and in further view of Massen et al ('769).
14. **Regarding claim 5:** The rejection has been previously set forth in paragraph 44 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.

Obviousness Rejection III

15. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling et al ('759) in view of Waddington et al (2003/0100699) and Hinz et al ('969).

16. **Regarding claim 19:** The rejection has been previously set forth in paragraphs 46-48 of the non-final rejection mailed 6/18/2009 and are herein incorporated by reference.

Allowable Subject Matter

17. **Claims 3 and 13** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Applicants discussion on page 12 of their response filed 8/6/2009 has been noted and is persuasive. Examples 8 and 9, in applicants' specification, establish an unexpected advantage in reduction in odor when using a polyether polyol solvent. However, claim 1 is not currently limited to the polyether polyol solvent of example 9 and as a result applicants' remarks are not commensurate in scope with the breadth of claim 1. In order to put the claimed invention in condition for allowance the limitations of claims 3 or 13 – which reflect the polyether polyol solvent of example 9 must be incorporated into claim 1.

19. Furthermore, if applicants decide to incorporate the subject matter of the objected claims into claim 1, then applicants are also required to cancel claims 2 and 12 so that no issues are raised under 35 U.S.C. 112 2nd paragraph.

Response to Arguments

20. Applicant's arguments filed 8/6/2009 with respect to the rejection of claims 1-2, 4-8, 10-12, 14-21 have been considered but are not persuasive.

21. The examiner would like to first restate, in brief, the current rejection sets forth: the primary reference (Schilling et al) teaches a method of producing (X) polyurethane from (I) polyether polyol, wherein (I) is produced by mixing (Ia) initiator with (Ib) polyether polyol solvent – this mixture containing (Ia) and (Ib) is then alkoxyalated to yield (I).

22. The current prima facie case of obviousness states that **it is obvious to replace the (Ia) initiator of Schilling et al for the (IIa) initiator of Waddington et al** since it eliminates the need for external amine catalyst later in the production of the (X) polyurethane. Whether or not the (Ib) polyether solvent of Schilling et al is present in the reaction system **was never a point of contention**; (Ib) is always present in the primary reference. With this understanding, applicants' remarks on pages 10 and 11 of the response filed 8/6/2009 fail to argue the current prima facie case of obviousness.

23. Instead applicants argue it would not be obvious to arrive at the claimed process since there is no motivation to utilize the (Ib) polyether polyol solvent of Schilling et al with the (IIa) initiators of Waddington et al since (Ib) is used to dissolve solid initiators, and (IIa) is already liquid at room temperature – as established by applicants' listing of melting temperatures for (IIa).

24. While it *may* not be obvious to include the (Ib) polyether solvent of Schilling et al in the alkoxylation step of Waddington et al – the rejection never alleges that it would obvious to include (Ib) in the alkoxylation step of Waddington et al (see paragraph 29 of the instant rejection). Instead, it is obvious to replace the (Ia) initiator of Schilling et al with the (IIa) initiator of Waddington et al since it produces (I) polyether polyol that eliminates the need for external amine catalyst later in the production of (X) polyurethane. **Using an argument to say**

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that it is not be obvious to combine (Ib) with (IIa) because (IIa) is already liquid does not overcome the fact it is obvious to select (IIa) over (Ia) (emphasis added).

25. Furthermore, if applicants maintain that it would not be obvious to combine (Ib) and (IIa) because (IIa) is liquid at room temperature, it should be noted that Schilling et al provides additional motivation to use (Ib): it produces (I) polyether polyol having reduced "amounts of low functionality diols" - i.e. there is better control of desired final product (See column 2 lines 24-30 - specifically lines 29-30).

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be

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reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J Gillespie/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796